UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,037	12/29/2000	Peter J. Sallaway	P04756 (NATI15-04756)	7732

7590	05/19/2004

DOCKET CLERK
P.O. DRAWER 800889
Dallas, TX 75380

EXAMINER
MOORE, IAN N

ART UNIT	PAPER NUMBER
2661	5

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/751,037	SALLAWAY ET AL.
	Examiner	**Art Unit**	
	Ian N Moore	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *39-51* is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 5

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7,9-16,18-24, and 26-37 are rejected under 35 U.S.C. 102(b) as being anticipated

by Herve (U.S. 5,740,163).

Regarding Claims 1,9, 10, 18,26, 27, 30 and 31, Herve'163 discloses a network

transceiver that is couplable to a computer system **(see FIG. 1, Dual-mode ISDN/STN**

transmitter/receiver which couples to the terminal) and the method of operating said

network transceiver to allow operating modes thereof to be monitored and controlled,

comprising:

an encoder **(see FIG. 1, the combined system of Audio/Video encoder CODEC**

13/14/6/25) that encodes data to be transmitted by said network transceiver **(see col. 1, lines**

29-35; see col. 2, lines 39-44, 56-66; note that each encoder encodes the transmit data by

the terminal);

a decoder **(see FIG. 1, the combined system of Audio/Video decoder CODEC**

13/14/6/25) that decodes data received by said network transceiver **(see col. 1, lines 29-35;**

see col. 2, lines 39-44, 56-66; note that each decoder decodes the received data by the

terminal); and

a controller (see FIG. 1, Management System 18), associated with said decoder and

said encoder (see FIG. 1, note that Management System associates/relates to the encoder

and decoder by way of Mux/Demux 14 and a switch 28), that controls operating modes of

said network transceiver (see col. 3, lines 19-40; Management System 18

manages/controls the operation modes of the terminal), comprising:

an encoder portion operable to direct said encoder to encode data (see FIG. 1,

CODEC 13 and 6 are directed to perform/encode in RNIS, and/or CODEC 24 and 25

are directed to perform/encode in RTC) in one of an industry-compliant mode (see FIG. 1,

ISDN mode when the switch 28 is at RNIS) and a custom mode (see FIG. 1, STM mode

when the switch 28 is at RTC; see col. 3, lines 40-65); and

a decoder portion operable (see FIG. 1, CODEC 13 and 6 are directed to

perform/decode in RNIS, and/or CODEC 24 and 25 are directed to perform/decode in

RTC), in response to sensing data received in said custom mode at said decoder (see col. 3,

lines 63 to col. 4, lines 5; note that the data is received at the decoder in STM mode), to

direct:

said decoder to decode said received data in said custom mode (see FIG. 1, note that

in STM mode switch 28 must be toggled to RTC; upon receiving the data in STM mode,

STM decoder RTC 34/38 must be directed/programmed/assigned to decode the data;

also note that per FIG. 1 and 2, it is clear that each STM decoder part/portion must

decode the data); and

said encoder portion to direct said encoder to encode data in said custom mode (see

FIG. 1; during STM mode, STM encoder RTC 33/37 must be

directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is

clear that each STM encoder part/portion must encode the data); see col. 3, lines 40-65.

Regarding Claims 2,11,19 and 32, Herve'163 discloses a state machine (see FIG. 1,

the combined system of management terminal, HDLC controller 21, and switch 28) that

includes at least two alternate states indicating whether said custom mode is enabled (see col.

3, lines 19-40,62-67 to col. 4, lines 2; note that the combined management system

controls both STM and ISDN modes, and controller indicates the STM mode by

enabling the switch to RTC).

Regarding Claims 3,12,20 and 33, Herve'163 discloses wherein at least said decoder

portion is embodied in a peripheral card that is couplable to a computer system (see FIG. 1,

the combined system of Audio/Video decoder CODEC 13/14/6/25 portion/chip/ASIC

must be attached/embodied in a peripheral card/unit which is coupled to the

terminal/system which has a capability to compute/determine which mode to use) to

allow said computer system to process said decoded data (see FIG. 1, the

computing/determining terminal/system process decoded data); see col. 1, lines 29-35;

see col. 2, lines 39-44, 56-66.

Regarding Claims 4,13,21 and 34, Herve'163 discloses a reset portion (see FIG. 1, a

switch 28) that is operable to direct said controller to reset said operating mode of the

network transceiver to said industry-compliant mode (see FIG. 1, note that switch 28 is

controlled by the combined management system to reset/switch from STM mode (RTC)

to ISDN mode (RNIS); see col. 3, lines 60-65.)

Regarding Claims 5,14,22 and 35, Herve'163 discloses wherein said reset portion is

associated with said decoder portion and operates to direct said decoder portion (**see FIG. 1,**

CODEC 13 and 6 RNIS are associated/related to switch 28 RNIS mode, they

operate/perform/direct the decoding in RNIS) to direct:

said decoder to decode said received data in said industry-compliant mode (**see FIG.**

1, note that in ISDN mode switch 28 must be toggled to RNIS; upon receiving the data

in RNIS mode, ISDN decoder RNIS 32/36 must be directed/programmed/assigned to

decode the data; also note that per FIG. 1 and 2, it is clear that each ISDN decoder must

decode the data); and

said encoder portion to direct said encoder to encode data in said industry-compliant

(**see FIG. 1; during ISDN mode, ISDN encoder RNIS 31/35 must be**

directed/programmed/assigned to encode the data; also note that per FIG. 1 and 2, it is

clear that each ISDN encoder part/portion must encode the data); see col. 3, lines 40-65.

Regarding Claims 6,15,23 and 36, Herve'163 discloses wherein said decoder portion

is further operable, in response to sensing data received in said industry-compliant mode at

said decoder (**see col. 3, lines 63 to col. 4, lines 5; note that the data is received at the**

decoder in ISDN mode), to direct said decoder to decode said received data from said

industry-compliant mode (**see FIG. 1, upon receiving the data in RNIS mode, ISDN**

decoder RNIS 32/36 must be directed/programmed/assigned to decode the data; also

note that per FIG. 1 and 2, it is clear that each ISDN decoder part/portion must decode

the data); see col. 3, lines 40-65.

Regarding Claims 7,16,24 and 37, Herve'163 discloses wherein said decoder portion

is further operable to direct said encoder portion to control data transmission from said

encoder in said industry-compliant mode (see FIG. 1; note that in ISDN mode switch 28

must be toggled to RNIS, and both encoder and decoder must perform in ISDN mode,

respectively. Then, ISDN encoder RNIS 31/35 must be directed/programmed/assigned

to encode the data; also note that per FIG. 1 and 2, it is clear that each ISDN encoder

part/portion must encode the data); see col. 3, lines 40-65.

Regarding Claim 28, Herve'163 discloses encoding data in said industry-compliant

mode (see FIG. 1, note that in ISDN mode, the switch 28 is toggled to RNIS; in RNIS

mode, encoders RNIS 31/35 must encode the data); see col. 3, lines 40-6.

Regarding Claim 29, Herve'163 discloses decoding data in said industry-compliant

mode (see FIG. 1, note that in ISDN mode, the switch 28 is toggled to RNIS; in RNIS

mode, decoders RTC 32/36 must decode the data); see col. 3, lines 40-6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2. Claims 8,17,25 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Herve'163 in view of Agazzi (U.S. 6,721,916).

Regarding claims 8,17,25 and 38, Herve'163 discloses wherein said industry-

compliant mode as describe above in claims 1,9,18 and 26.

Herve'163 does not explicitly disclose IEEE 802.3ab.

However, the above-mentioned claimed limitations are taught by Agazzi'916. In

particular, Agazzi'916 teaches wherein said industry-compliant mode is compliant with IEEE

802.3ab **(see FIG. 1, Transceiver block 102 which operates in conformance with IEEE**

802.ab. standard; see col. 1, line 34-34, see col. 6, lines 11-20).

In view of this, having the system of Herve'163 and then given the teaching of

Agazzi'916, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the system of Herve'163, by utilizing IEEE 802.ab. as

industrial/standard mode, as taught by Agazzi'916. The motivation to combine is to obtain

the advantages/benefits taught by Agazzi'916 since Agazzi'916 states at col. 1, line 46 to col.

2, lines 4 that such modification would provide a smooth and non-disruptive evolution from

existing standard, and lower cost than other technologies of comparable speed.

Allowable Subject Matter

3. Claims 39-51 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter:

Claims 39-51 are allowable over the prior art of record since the cited reference taken individually or in combination fails to particularly disclose the following BOLD limitations:

In claims 39, 43 and 47, ... repeatedly direct, in response to entering said master/slave state, said encoder to encode data to be transmitted to said another computer in an industry-compliant mode/custom mode and, if said encoded data is not properly received by said another computer, to encode data to be transmitted to said another computer in a custom mode/industry-compliant mode, ... until said encoded data is properly received...in combination with other limitations recited as specified in Claims 39,43 and 47.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N Moore whose telephone number is 703-605-1531. The examiner can normally be reached on M-F: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 703-305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

INM
5/13/04

RICKY NGO
PRIMARY EXAMINER